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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/004,271	10/31/2001	Mark P. Cauchon	CAUCHON et al.-PA-1	3845

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Law Offices of Royal W. Craig
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EXAMINER
RIES, LAURIE ANNE

ART UNIT	PAPER NUMBER
2176	

DATE MAILED: 09/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>31 October 2001</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-7</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-7</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>28 March 2002</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Specification

The disclosure is objected to because it contains an embedded hyperlink

and/or other form of browser-executable code. Applicant is required to delete the

embedded hyperlink and/or other form of browser-executable code. See MPEP §

608.01.

- Page 4, line 10 – reference to http://www.quickforms.net/

- Page 4, line 21 – reference to http://www.legaldocs.com

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for

all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described
as set forth in section 102 of this title, if the differences between the subject matter sought to
be patented and the prior art are such that the subject matter as a whole would have been
obvious at the time the invention was made to a person having ordinary skill in the art to which
said subject matter pertains. Patentability shall not be negatived by the manner in which the
invention was made.

Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Heston (U.S. Publication 2002/0019741 A1) in further view of Tran (U.S.

Patent 6,157,935), Accarie (U.S. Patent 6,502,144 B1), Wegner (U.S. Patent

6,032,192), Inala (U.S. Patent 6,442,590 B1), and Buchanan (U.S. Patent

5,267,155).

As per claim 1, Heston discloses a method for automated provisioning of

legal documents including the creation and use of legal forms. (See Heston,

Page 2, paragraph 0015). Heston also discloses receiving payment for a legal

document using at least a portion of the user information received from the user.

(See Heston, Page 7, paragraph 0127). Heston does not disclose expressly that

the legal forms are generic and stored in a database. Heston also does not

disclose expressly receiving user information from a user over an electronic

communications link and packetizing the user information, rendering a

personalized legal document for the user by selectively merging the packetized

user information into the generic legal form, and delivering the personalized legal

document to the user in a secondary browser window on the user's computer

screen by RTF document export. Tran discloses the use of generic forms stored

on a database. (See Tran, Column 37, lines 4-14). Accarie discloses receiving

user information over a network, or communications link, and packetizing the

user information. (See Accarie, Column 10, lines 55-67, and Column 11, lines 1-

5). Buchanan discloses rendering a personalized document for a user by

selectively merging the user information into the generic form or template. (See

Buchanan, Column 2, lines 54-67, Column 3, lines 1-2, and Claims 1 and 4).

Inala discloses delivering a document in a secondary browser window. (See

Inala, Column 10, lines 58-67, and Column 11, lines 1-3). Wegner discloses

using RTF as a means of document export. (See Wegner, Column 8, lines 55-

67, and Column 9, lines 1-3). Heston, Tran, Accarie, Wegner, Inala, and

Buchanan are analogous art because they are from the same field of endeavor of

electronic document processing. At the time of the invention it would have been

obvious to a person of ordinary skill in the art to combine the generic forms

database of Tran, the packetized user information of Accarie, the personalized

document of Buchanan, the secondary browser window of Inala, and the use of

RTF document export of Wegner. The motivation for combining Tran with

Heston would have been to optimally manage the data. (See Tran, Column 36,

lines 6-11). Therefore, it would have been obvious to combine Tran with Heston

for the benefit of managing the data. The motivation for combining Accarie with

Heston and Tran would have been to allow for the sharing of the input/output

resource between two data processing apparatuses. (See Accarie, Column 2,

lines 49-52). Therefore, it would have been obvious to combine Accarie with

Heston and Tran for the benefit of sharing multiple input/output resources. The

motivation for combining Buchanan with Heston, Tran and Accarie would have

been to generate user-defined reports. (See Buchanan, Column 2, lines 54-57).

Therefore, it would have been obvious to combine Buchanan with Heston, Tran

and Accarie for the benefit of creating user-defined reports. The motivation for

combining Inala with Heston, Tran, Accarie and Buchanan would have been to

enable the user to view the document without giving up his or her current page or

current status. (See Inala, Column 10, lines 64-65). Therefore, it would have

been obvious to combine Inala with Heston, Tran, Accarie and Buchanan for the

benefit of maintaining the user's current view or status in the first browser

window. The motivation for combining Wegner with Heston, Tran, Accarie,

Buchanan, and Inala would have been to provide a common format for document

transmission which can be imported by most word processing packages. (See

Wegner, Column 9, lines 1-3). Therefore, it would have been obvious to combine

Wegner with Heston, Tran, Accarie, Buchanan, and Inala for the benefit of providing a common document format. It would have been obvious to combine Heston, Tran, Accarie, Buchanan, Inala and Wegner for the benefit of providing and storing generic legal forms capable of receiving packets of user information to create a personalized legal document which could be sent to a user via a common format, such as RTF, and viewed in a separate browser window by the user thus enabling the user to maintain his or her current page in the first browser window to obtain the invention as specified in claim 1.

As per claim 2, Heston, Tran, Accarie, Buchanan, Inala and Wegner disclose the limitations of claim 1 as described above. Heston also discloses taking information specific to a particular legal matter from an HTML questionnaire and transferring the information back from the HTML questionnaire directly back to the server. (See Heston, Page 7, paragraph 0125).

As per claim 3, Heston, Tran, Accarie, Buchanan, Inala and Wegner disclose the limitations of claim 2 as described above. Buchanan also discloses including a recursive document assembly process that merges information into a skeleton form document selected in accordance with the particular legal matter. (See Buchanan, Column 2, lines 54-68, and Column 3, lines 1-13). Heston, Tran, Accarie, Wegner, Inala, and Buchanan are analogous art because they are from the same field of endeavor of electronic document processing. At the time of the invention it would have been obvious to a person of ordinary skill in the art to combine the recursive document assembly process that merges user information into the skeleton form of Buchanan with the system and method of

Heston, Tran, Accarie, Buchanan, Inala and Wegner. The motivation for doing

so would have been to allow for the generation of user-defined reports. (See

Buchanan, Column 2, lines 54-57). Therefore, it would have been obvious to

combine Buchanan with Heston, Tran, Accarie, Buchanan, Inala and Wegner for

the benefit of creating user-defined reports to obtain the invention as specified in

claim 3.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over

Heston (U.S. Publication 2002/0019741 A1), Tran (U.S. Patent 6,157,935),

Accarie (U.S. Patent 6,502,144 B1), Buchanan (U.S. Patent 5,267,155), Inala

(U.S. Patent 6,442,590 B1) and Wegner (U.S. Patent 6,032,192) as applied to

claim 3 above, and further in view of Iwai (U.S. Patent 5,119,491).

As per claim 4, Heston, Tran, Accarie, Buchanan, Inala and Wegner

disclose the limitations of claim 3 as described above. Heston, Tran, Accarie,

Buchanan, Inala and Wegner do not disclose expressly assembling the

completed document line by line. Iwai discloses analyzing a document line by

line. (See Iwai, Column 6, lines 32-33). Heston, Tran, Accarie, Wegner, Inala,

Buchanan and Iwai are analogous art because they are from the same field of

endeavor of electronic document processing. At the time of the invention it would

have been obvious to combine the line by line processing of Iwai with the

document assembly process of Heston, Tran, Accarie, Buchanan, Inala and

Wegner. The motivation for doing so would have been to allow for document

formatting that is easily manipulated. (See Iwai, Column 2, lines 5-8). Therefore,

it would have been obvious to combine Iwai with Heston, Tran, Accarie,

Buchanan, Inala and Wegner for the benefit of allowing for a document format

that is easy to manipulate to obtain the invention as specified in claim 4.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over

Heston (U.S. Publication 2002/0019741 A1), Tran (U.S. Patent 6,157,935),

Accarie (U.S. Patent 6,502,144 B1), Buchanan (U.S. Patent 5,267,155), Inala

(U.S. Patent 6,442,590 B1), Wegner (U.S. Patent 6,032,192) and Iwai (U.S.

Patent 5,119,491) as applied to claim 4 above, and further in view of Meyerzon

(U.S. Patent 6,199,081 B1).

As per claim 5, Heston, Tran, Accarie, Buchanan, Inala, Wegner and Iwai

disclose the limitations of claim 4 as described above. Heston, Tran, Accarie,

Buchanan, Inala, Wegner and Iwai do not disclose expressly that information is

identified by meta-tags. Meyerzon discloses the use of meta-tags to identify

data. (See Meyerzon, Column 1, lines 35-39). Heston, Tran, Accarie,

Buchanan, Inala, Wegner, Iwai and Meyerzon are analogous art because they

are from the same field of endeavor of electronic document processing. At the

time of the invention it would have been obvious to combine the meta-tags of

Meyerzon with the questionnaire, skeleton document and document assembly

process and delivery of Heston, Tran, Accarie, Buchanan, Inala, Wegner and

Iwai. The motivation for doing so would have been to define the meta-data

included in the HTML document. (See Meyerzon, Column 1, lines 36-37).

Therefore, it would have been obvious to combine Meyerzon with Heston, Tran,

Accarie, Buchanan, Inala, Wegner and Iwai for the benefit of defining the meta-

data in the HTML questionnaire to obtain the invention as specified in claim 5.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over

Heston (U.S. Publication 2002/0019741 A1) in further view of Inala (U.S. Patent

6,442,590 B1), Plotkin (U.S. Publication 2001/0051962 A1), and Iwai (U.S.

Patent 5,119,491).

As per claim 6, Heston discloses a method of document assembly that

includes requiring a user to complete an online questionnaire with personalized

information (See Heston, Page 7, paragraph 0125), securing payment

authorization from the user (See Heston, Page 7, paragraph 0127), and

outputting an HTML form to the user that contains a URL to an output file (See

Heston, Claims 41 and 42). Heston does not disclose expressly maintaining a

database of form documents, merging the personalized information from the

HTML questionnaire line by line and writing selected information in RTF format to

an output file, and opening a secondary browser window upon user-selection of

the pointer and displaying the RTF document therein. Plotkin discloses

maintaining a database of form documents. (See Plotkin, Page 6, paragraph

0052). Plotkin also discloses writing the information to an output file (See

Plotkin, Page 5, paragraph 0043), and that the output file is in RTF format (See

Plotkin, Page 3, paragraph 0031). Iwai discloses processing a file line by line.

(See Iwai, Column 6, lines 32-33). Inala discloses opening a secondary browser

window. (See Inala, Column 10, lines 58-67, and Column 11, lines 1-3). Heston,

Inala, Plotkin, and Iwai are analogous art because they are from the same field of

endeavor of electronic document processing. At the time of the invention it would

have been obvious to a person of ordinary skill in the art to combine the forms

database and processing of an output file in RTF format of Plotkin, the line by

line processing of Iwai, and the opening of a secondary browser window of Inala

with the method of document assembly of Heston. The motivation for combining

the the forms database and processing of an output file in RTF format of Plotkin

with the method of document assembly of Heston would have been to enable a

user to modify the fixed information saved in the document assembly system.

(See Plotkin, Page 2, paragraph 0013). Therefore, it would have been obvious to

combine Plotkin with Heston for the benefit of allowing the user to update the

fixed data in the document. The motivation for combining Iwai with Heston and

Plotkin would have been to allow for document formatting that is easily

manipulated. (See Iwai, Column 2, lines 5-8). Therefore, it would have been

obvious to combine Iwai with Heston and Plotkin for the benefit of allowing for a

document format that is easy to manipulate. The motivation for combining Inala

with Heston, Plotkin and Iwai would have been to enable the user to view the

document without giving up his or her current page or current status. (See Inala,

Column 10, lines 64-65). Therefore, it would have been obvious to combine

Inala with Heston, Plotkin and Iwai for the benefit of maintaining the user's

current view or status in the first browser window. It would have been obvious to

combine Heston, Plotkin, Iwai and Inala for the benefit of easily modifying fixed

data and easily manipulating the formatting of forms stored in the forms

database, as well as allowing the user to maintain his or her current view in a first browser window to obtain the invention specified in claim 6.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Heston (U.S. Publication 2002/0019741 A1) in further view of Tran (U.S. Patent 6,157,935), Wegner (U.S. Patent 6,032,192), Inala (U.S. Patent 6,442,590 B1), Buchanan (U.S. Patent 5,267,155), Rowe (U.S. Publication 2003/0171145 A1), and Harr.

As per claim 7, Heston discloses a method of rendering a personalized legal document for a user including the use of legal forms (See Heston, Page 2, paragraph 0015), and including collecting information on the user's legal needs (See Heston, Claims 18 and 23, and Page 1, paragraph 0008). Heston does not disclose expressly that the forms are generic forms stored on a database, that the user information is collected without requiring identification information from the user, that an attorney chooses a suitable legal form from the database, that a personalized legal document is rendered for the user by selectively merging the user information into the selected generic form, and that the personalized legal document is delivered to the user in a secondary browser window on the user's computer screen by RTF document export. Tran discloses the use of generic forms stored on a database. (See Tran, Column 37, lines 4-14). Wegner discloses using RTF as a means of document export. (See Wegner, Column 8, lines 55-67, and Column 9, lines 1-3). Inala discloses delivering a document in a secondary browser window. (See Inala, Column 10, lines 58-67, and Column 11,

lines 1-3). Buchanan discloses rendering a personalized document for a user by selectively merging the user information into the generic form or template. (See Buchanan, Column 2, lines 54-67, Column 3, lines 1-2, and Claims 1 and 4). Rowe discloses the exclusion of user identification information (See Rowe, Page 16, paragraph 0135). Harr discloses that an attorney chooses a form for a client. (See Harr, Page 206). Heston, Tran, Wegner, Inala, Buchanan, Rowe and Harr are analogous art because they are from the same field of endeavor of electronic document processing. At the time of the invention it would have been obvious to a person of ordinary skill in the art to combine the generic forms database of Tran, the personalized document of Buchanan, the secondary browser window of Inala, the use of RTF document export of Wegner, the exclusion of user identification information of Rowe and the attorney form selection of Harr. The motivation for combining Tran with Heston would have been to optimally manage the data. (See Tran, Column 36, lines 6-11). Therefore, it would have been obvious to combine Tran with Heston for the benefit of managing the data. The motivation for combining Buchanan with Heston and Tran would have been to generate user-defined reports. (See Buchanan, Column 2, lines 54-57). Therefore, it would have been obvious to combine Buchanan with Heston and Tran for the benefit of creating user-defined reports. The motivation for combining Inala with Heston, Tran, and Buchanan would have been to enable the user to view the document without giving up his or her current page or current status. (See Inala, Column 10, lines 64-65). Therefore, it would have been obvious to combine Inala with Heston, Tran, and Buchanan for the benefit of

maintaining the user's current view or status in the first browser window. The

motivation for combining Wegner with Heston, Tran, Buchanan, and Inala would

have been to provide a common format for document transmission which can be

imported by most word processing packages. (See Wegner, Column 9, lines 1-

3). Therefore, it would have been obvious to combine Wegner with Heston,

Tran, Buchanan, and Inala for the benefit of providing a common document

format. The motivation for combining Rowe with Heston, Tran, Buchanan, Inala

and Wegner would have been to maintain user anonymity. (See Rowe, Page 16,

paragraph 0135). Therefore, it would have been obvious to combine Rowe with

Heston, Tran, Buchanan, Wegner, and Inala for the benefit of maintaining user

anonymity. The motivation for combining Harr with Heston, Tran, Buchanan,

Inala, Wegner and Rowe would have been to allow attorneys or legal experts to

use the document models to prepare customized draft documents for their

clients. (See Harr, Page 206, paragraph 2). Therefore, it would have been

obvious to combine Harr with Heston, Tran, Buchanan, Inala, Wegner and Rowe

for the benefit of allowing legal experts or attorneys to prepare customized legal

documents for clients. It would have been obvious to combine Heston, Tran,

Buchanan, Inala, Wegner, Rowe and Harr for the benefit of providing and storing

generic legal forms selectable by an attorney or legal expert, and collecting user

information without the need for user identification to maintain anonymity, to

create a personalized legal document which could be sent to a user via a

common format, such as RTF, and viewed in a separate browser window by the

user thus enabling the user to maintain his or her current page in the first

browser window to obtain the invention as specified in claim 7.

Conclusion

The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure.

- Wells (U.S. Publication 2004/0024714 A1) discloses an electronic

  safe deposit box system.

- Hoyt (U.S. Patent 6,067,531) discloses an automated contract

  negotiator/generation system and method.

- Fagg III (U.S. Patent, 5,960,419) discloses an authoring tool for a

  computer implemented decision management system.

- Lauritsen discloses the forms and use of knowledge in the creation

  of legal documents.

Any inquiry concerning this communication or earlier communications from

the examiner should be directed to Laurie Ries whose telephone number

is currently (703) 605-1238. After mid-October, 2004, the examiner can

be reached at (571) 272-4095. The examiner can normally be reached on

Monday-Friday from 7:00am to 3:30pm.

Information regarding the status of an application may be obtained from

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PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have any questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LAR

JOSEPH FEILD
SUPERVISORY PATENT EXAMINER